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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/616,945	07/11/2003	Heiner Glombik	02481.1832	2047
5487	7590	11/02/2005	EXAMINER PESELEV, ELLI	
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			ART UNIT 1623	
DATE MAILED: 11/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/616,945

Applicant(s)

GLOMBIK ET AL.

Examiner

Elli Peselev

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☒ Claim(s) 19-30 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 20-29 have been renumbered 21-30.

Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the compounds wherein R1 and R2 are both hydrogens and wherein R1 is CF₃ and R2 is hydrogen, does not reasonably provide enablement for R1 and R2 being many other groups as encompassed by claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

A conclusion of lack of enablement means that, based on the evidence regarding each of the factors below, the specification, at the time the application was filed, would not have taught one skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.

(A) The breadth of the claims;

The instant claims encompass compounds having a large number of possible substituents represented by the variables R1 and R2 having different structural formulas such as halogens, OH, NO₂, CN, COOH, CO(C1-C6)-alkyl, COO(C1-C6)-alkyl, CONH₂, phenyl, benzyl, SO₂-NH₂, SO₂NH(C1-C6)-alkyl, etc.

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(B) The nature of the invention;

The invention is directed to compounds useful for treating diabetes.

(C) The state of the prior art;

The treatment of diabetes with thiophene glycosides is not known in the art.

(D) The level of one of ordinary skill;

(E) The level of predictability in the art;

It is well known in the pharmaceutical art that even minor variations in the structural formula of a chemical compound can lead to major differences in its properties and activity. However, the instant claims encompass compounds having major differences in structural formulas. For example, a person having ordinary skill in the art would not be able to predict that a claimed compound wherein R1 SO-(CH₂)₆-phenyl substituted by C₆-alkoxy and R2 is NH(C₇)-acyl would have a similar activity as a compound wherein both R1 and R2 are hydrogens.

One of ordinary skill in the art would be a Physician with an M.D./PhD.

(F) The amount of direction provided by the inventor;

The inventor has not provided any direction how to make various substituents represented by the variables R1 and R2.

(G) The existence of working examples;

All the working examples except one are directed to compounds wherein both R1 and R2 are hydrogens and one working example is directed to a compound wherein R1 is CF₃ and R2 is hydrogen. There are no examples on how to make and use any other compounds, and

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(H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

Since the claims encompass such a large number of possible substituents represented by the variables R1 and R2 and since there are no working examples showing how to make and use said compounds, it would take an undue amount of experimentation to determine how to make said compounds and to determine whether said compounds are useful in treating diabetes.

Claims 19-30 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's arguments filed August 24, 2005 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elli Peselev whose telephone number is (571) 272-0659. The examiner can normally be reached on 8.00-4.30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Elli Peselev

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